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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SIMON A. J. HOLDSWORTH

Appeal 2008-2482
Application 10/016,935¹
Technology Center 2100

Decided:² March 17, 2009

Before ROBERT E. NAPPI, SCOTT R. BOALICK, and
KEVIN F. TURNER, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

¹ Application filed December 14, 2001. The real party in interest is IBM Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the rejection of claims 1-14 and 16, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellant's invention relates to the selection of an appropriate communication strategy for message brokers to be used for inter-broker communications within a network. (Spec. 1:13-17.)

Claim 1 is exemplary:

1. A message brokering system for providing a publish/subscribe service for publisher and subscriber application programs, comprising:

means for receiving published messages from one or more publisher application programs;

means for forwarding received messages to connected message brokering systems;

means, responsive to a communication characteristic of an inter-broker communication link between the message brokering system and one of said connected message brokering systems, for selecting a message filtering policy which is appropriate for the communication characteristic; and

means for controlling the forwarding of messages via the inter-broker communication link using the selected message filtering policy, wherein

the means for selecting a message filter policy is separate from the publisher and subscriber application programs.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Owens	US 6,633,630 B1	Oct. 14, 2003 (filed Sep. 12, 1998)
Hurst	US 6,131,123	Oct. 10, 2000
Narasimhan	US 6,073,165	Jun. 6, 2000
Khan	US 2002/0143951 A1	Oct. 3, 2002
Delaney	US 2001/0027479 A1	Oct. 4, 2001

Claims 1-4, 10-14, and 16 stand rejected under 35 U.S.C. § 103(a) as being obvious over Owens and Narasimhan.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being obvious over Owens, Narasimhan, Hurst, and Khan.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being obvious over Owens, Narasimhan, and Delaney.

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being obvious over Owens, Narasimhan, Delaney, and Khan.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs³ and the Answer⁴ for their respective details. Except as noted in this opinion, Appellant has not presented any substantive

³ We refer to the Appeal Brief filed August 11, 2006 ("App. Br."), the Reply Brief filed October 10, 2006 ("First Reply Br."), and the Reply Brief filed December 4, 2006 ("Second Reply Br.") throughout this opinion.

⁴ We refer to the Examiner's Answer mailed September 8, 2006 ("Ans.") and the Communication mailed November 2, 2006 ("November Communication") throughout this opinion.

arguments directed separately to the patentability of the dependent claims or related claims in each group. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii). Only those arguments actually made by Appellant in the Briefs have been considered in this opinion. Arguments that Appellant did not make in the Briefs have not been considered and are deemed to be waived. *See id.*

ISSUE

Appellant argues that "Owens does not teach the claimed means for selecting a message filtering policy which is appropriate for the communication characteristic" (App. Br. 5; *see also* First Reply Br. 6-8) and "Narasimhan's rerouting based upon a communication characteristic is not comparable to the claimed selecting a message filtering policy appropriate for a communication characteristic" (App. Br. 5; *see also* First Reply Br. 8-11). Appellant also argues that "Owens does not teach automatically selecting filtering policies" (App. Br. 6) and the "[p]roposed combination would not result in [the] claimed invention" (App. Br. 7; *see also* First Reply Br. 11-12). Appellant further argues that independent claims 1, 11, and 14 "have been amended to recite that 'the means for selecting a message filter policy is separate from the publisher and subscriber application programs.'" (First Reply Br. 4; *see also* Second Reply Br. 1-4.) In addition, "Appellant argued that the proposed modification would impermissibly change the principle of operations [sic] of Owens." (App. Br. 7; *see also* First Reply Br. 5; Second Reply Br. 2-3.)

We note that the Briefs refer to arguments previously made on various pages of the "Second Amendment" dated October 13, 2005. (*See, e.g.*, App. Br. 5-8 (referring to a number of arguments made on pages 8-15 of the "Second Amendment").) This attempt to incorporate arguments by reference does not comply with our rules. In order for arguments to be considered by the Board, they must be included in the Briefs. 37 C.F.R. § 41.37(c)(1)(vii) ("Any arguments or authorities not included in the brief or a reply brief . . . will be refused consideration by the Board, unless good cause is shown."). Appellant has not shown good cause why arguments made in the "Second Amendment" but not included in the Briefs should be considered. Therefore, we will treat arguments made in the "Second Amendment" but not included in the Briefs as waived.

Appellant's arguments present the following issue:

Has Appellant shown that the Examiner erred in rejecting claims 1-14 and 16 under 35 U.S.C. § 103(a)?

The resolution of this issue turns on the following subsidiary issues:

1. Has Appellant shown that the Examiner erred in finding that the combination of Owens and Narasimhan teaches or suggests a means "for selecting a message filtering policy which is appropriate for the communication characteristic"?

2. Has Appellant shown that the Examiner erred in finding that the combination of Owens and Narasimhan teaches or suggests that "the means for selecting a message filter policy is separate from the publisher and subscriber application programs"?

3. Has Appellant shown that the Examiner erred by combining the applied references because the proposed modification would impermissibly change the principle of operation of Owens?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Owens describes a system for integrating electronic communications, such as e-mail, voice mail, and fax messages, in a universal mailbox. (Col. 1, ll. 11-17; Abstract.) "Message receivers may access their messages with a telephone or a computer regardless of the communication medium used by the message sender." (Abstract.)
2. Referring to Figure 1, Owens teaches that the universal mailbox may include more than one message repository 10, 12. (Col. 5, ll. 61-62.) "Access to and communications with a message repository that is part of the universal mailbox may be facilitated by a computer access service provider such as the CompuServe Information Service [computer access service provider] 14." (Col. 6, ll. 19-23.) "Access to and communications with a universal mailbox message repository

may also be facilitated by a telephone access service provider such as Premiere Communications [telephone access service provider] 16." (Col. 6, ll. 23-26.) Figure 1 shows message repository 10 as part of the CompuServe Information Service 14 and message repository 12 as part of Premiere Communications 16. "[A] dedicated communication link 18 may be established between the repositories 10, 12 so messages may be transferred between repositories." (Col. 6, ll. 26-30.) A message sender 34 composes and sends a message to a computer access service provider 14, which is routed by the network node 26 to a communications server 28, which may make arrangements to forward the message to another service provider such as the telephone access service provider 16. (Col. 7, ll. 14-31.) The message may then be stored in the message repository 12 of the telephone access service provider 16. (Col. 7, ll. 31-34.) The message receiver 36 calls the telephone access service provider 16 to retrieve the message, which may be translated by the communications server 32. (Col. 7, ll. 34-37.) Thus, "[a]lthough the message sender 34 chose to communicate with the message receiver 36 via e-mail, using the present invention, the message receiver 34 is able to access the message using a different communication mode (i.e., the telephone 24)." (Col. 7, ll. 37-41.)

3. Narasimhan describes a message processing and forwarding system for processing electronic messages. (Abstract.) As shown in Figure 1, "[a] pair of message servers 103 and 105 are linked by a computer communication network (CCN) 111." (Col. 2, ll. 53-55.)

- "The ultimate source and destination of a message may be the first message source 115 and a receiver 133." (Col. 2, ll. 66-67.)
4. Narasimhan teaches that a "useful aspect of the embodiment in FIG. 1 is the provision for redundancy by the inclusion of an alternate source server 117, mirrored database 119, and alternate destination server 125." (Col. 6, l. 66 to col. 7, l. 2.) "The overall system may be configured to detect failures in either the source or destination servers, and database server 107, and replace their functions with an alternate server and/or mirrored database 119." (Col. 7, ll. 2-5.) "This may be accomplished by configuring the message servers 103 and 105 to recognize failure conditions (such as failure return codes, or lack of a successful return code) and accordingly reallocate resources in the event of failures with either the servers or the database, such that a message is rerouted via a redundant resource or connection to ensure that the message is reliably forwarded to the receiver 133." (Col. 7, ll. 5-12.) "The system will thus adaptively reconfigure itself in response to changing network and communication conditions." (Col. 7, ll. 13-15.)

PRINCIPLES OF LAW

All timely filed evidence and properly presented arguments are considered by the Board in resolving an obviousness issue on appeal. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a *prima facie* case of unpatentability. *Id.* at 1472.

When that burden is met, the burden then shifts to the Applicant to rebut. *Id.*; see also *In re Harris*, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the Applicant produces rebuttal evidence of adequate weight, the *prima facie* case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is the Appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [for obviousness] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court reaffirmed that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 1739. The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103

likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d at 988. "To facilitate review, this analysis should be made explicit." *KSR*, 127 S. Ct. at 1741. However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ."

Id.

During examination of a patent application, a claim is given its broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

ANALYSIS

§ 103 Rejection - Owens / Narasimhan

Claims 1, 4, 10-14, and 16

Appellant's arguments that the Examiner erred in rejecting representative claim 1⁵ as being obvious over Owens and Narasimhan are not persuasive.

The Examiner found that, while Owens does not expressly "teach details regarding selecting a message filtering policy based on a communication characteristic of a link between brokering systems. . . . Narasimhan discloses another message brokering system which discloses selecting a policy, based on the communication characteristic of the network (i.e. if server A is down, then go down the list of user defined available servers until an appropriate server is found which can route the message to the user) (col. 4, lines 30-63; col. 5, lines 25-30; col. 7, lines 1-15)." (Ans. 4; *see* FF 3-4.) The Examiner stated that "[i]t is the combination of Owens in view of Narasimhan which disclose[s] selecting a message filtering policy which deals with the communication characteristic of a communication link." (Ans. 13.) We agree with the Examiner.

Under the broadest reasonable interpretation consistent with the Specification, we agree with the Examiner that Narasimhan's "selection of an alternate destination server and determination of the computer network routing information required for sending the filtered message to the alternate destination server can be construed as the claimed 'selecting a message

⁵ Appellant argues claims 1, 4, 10-14, and 16 together as a group and states that "claims 4, 10-14, and 16 stand or fall together with independent claim 1." (App. Br. 4.) Accordingly, we select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

filtering policy based on a communication characteristic" (Ans. 14; *see also* FF 3-4). Appellant has not pointed to any particular definition of "communication characteristic" or "message filtering policy" in the Specification that would require a different interpretation.

The claimed "communication characteristic of an inter-broker communication link" is broad enough to encompass the characteristic of whether an inter-broker communication link is effective to communicate with a server. If the server is down, the link is not effective to communicate with that server. We also agree with the Examiner that a "message filtering policy" can mean "how to deal with the message" (Ans. 13). The claimed "message filtering policy" is broad enough to encompass a decision to communicate or not to communicate a message over a particular link. Therefore, the decision to communicate or not communicate a message over a particular link depending upon whether a server is up or down, as taught by Narasimhan, meets the claimed "selecting a message filtering policy which is appropriate for the communication characteristic." Appellant has not presented credible evidence or argument to shown error in the claim interpretation or in the fact finding regarding Narasimhan.

Therefore, Appellant has not shown that the Examiner erred in finding that the combination of Owens and Narasimhan teaches or suggests a means "for selecting a message filtering policy which is appropriate for the communication characteristic," as claimed.

Appellant's argument regarding whether Owens teaches automatically selecting filtering policies is not germane. As the Examiner has pointed out (Ans. 14), no such limitation is claimed.

Appellant's argument regarding the message filter policy selection means being separate is not convincing. As the Examiner stated in the November Communication, "Owens' message sender 34 can be construed as the publishing application and Owens' message receiver [sic] 24 can be construed as the subscriber application program." We agree with the Examiner's statement in the November Communication that "[e]verything inbetween the publisher and subscribers can be construed as 'separate.'" In particular, the CompuServe Service 14 and the Premiere Service 16 are inbetween the message sender 34 and the message receiver 24. (*See* FF 2; Owens, Fig. 1.) Also, the CompuServe Service 14 and/or the Premiere Service 16 will include a means for selecting a message filter policy (i.e., rerouting in event of failure) when the teachings of Owens are combined with the teachings of Narasimhan (*see* Ans. 4-5; FF 2-4), especially the teaching in Narasimhan that message servers 103 and 105 may be configured to recognize failure conditions (FF 4). Because the CompuServe Service 14 and the Premiere Service 16 are separate from the message sender 34 and the message receiver 24, the means for selecting a message filter policy is separate from the publisher and subscriber application programs.

Therefore, Appellant has not shown that the Examiner erred in finding that the combination of Owens and Narasimhan teaches or suggests that "the means for selecting a message filter policy is separate from the publisher and subscriber application programs," as claimed.

Appellant's argument that the proposed combination of Owens and Narasimhan would not result in the claimed invention is not persuasive. The Examiner has set forth a *prima facie* case explaining how each and every

claim limitation is met by the applied prior art. Appellant has not provided convincing evidence or argument to rebut the prima facie case.

Appellant's argument that the proposed modification would impermissibly change the principle of operation of Owens is not convincing. The Examiner found that "[i]t would have been obvious to one of ordinary skill in the art to combine the teaching of Owens with Narasimhan in order to incorporate a backup service to the system of Owens, thereby providing redundancy by using alternate source servers (i.e. the Premiere service of Owens), mirrored databases, and alternate destination servers (i.e. the CompuServe service of Owens) as supported by Narasimhan (col. 6, line 65 to col. 7, line 14)." (Ans. 4-5.) The Examiner found that this combination "would provide an ability for the users of the system of Owens to receive their messages via their respective systems even though the CompuServe server is down or a message is unreachable via the particular network or link, thereby ensuring that a message gets routed appropriately to the user." (Ans. 5.) Appellant has not provided convincing evidence or argument as to how incorporating a backup service, as taught by Narasimhan, in the system of Owens would impermissibly change the operating principle of Owens.

Therefore, Appellant has not shown that the Examiner erred by combining the applied references because Appellant has not shown that the proposed modification would impermissibly change the principle of operation of Owens.

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a). As discussed, claims 4, 10-14, and 16 were not argued separately and fall together with claim 1.

Claim 2

The Examiner presented a prima facie case of obviousness with respect to claim 2. (Ans. 5.) Appellant states that "[o]n pages 14 and 15 of the Second Amendment, Appellant separately argued that claim 2 further distinguishes the claimed invention over the applied prior art." (App. Br. 8.) However, no such arguments were presented in the Briefs. Therefore, as discussed *supra*, we consider these arguments with respect to claim 2 to be waived.

Accordingly, Appellant has not rebutted the Examiner's prima facie case of obviousness with respect to claim 2. Thus, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 2 under 35 U.S.C. § 103(a).

Claim 3

The Examiner presented a prima facie case of obviousness with respect to claim 3. (Ans. 5-6.) Appellant states that "[o]n page 15 of the Second Amendment, Appellant separately argued that the Examiner did not specifically identify, within the applied art, the teachings allegedly disclosing the claimed features recited in claim 3." (App. Br. 8.) However, no such arguments were presented in the Briefs. Therefore, as discussed *supra*, we consider the arguments with respect to claim 3 to be waived.

Accordingly, Appellant has not rebutted the Examiner's prima facie case of obviousness with respect to claim 3. Thus, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 3 under 35 U.S.C. § 103(a).

§ 103 Rejection - Owens / Narasimhan / Hurst / Khan

With respect to claims 5 and 6, Appellant summarily alleges that these claims are not unpatentable over the applied references for the same reasons discussed with respect to claim 1 and because "Hurst and Khan do not cure the argued deficiencies of Owens and Narasimhan." (App. Br. 8.) Because Appellant has not provided any arguments regarding Hurst and Khan, or any additional arguments for claim 1, we will sustain the rejection for the reasons discussed with respect to independent claim 1, from which claims 5 and 6 depend.

§ 103 Rejection - Owens / Narasimhan / Delaney

Appellant summarily alleges that claim 7 is not unpatentable over the applied references for the same reasons discussed with respect to claim 1 and because "Delaney does not cure the argued deficiencies of Owens and Narasimhan." (App. Br. 8-9.) Because Appellant has not provided any arguments regarding Delaney, or any additional arguments for claim 1, we will sustain the rejection for the reasons discussed with respect to independent claim 1, from which claim 7 depends.

§ 103 Rejection - Owens / Narasimhan / Delaney / Khan

With respect to claims 8 and 9, Appellant summarily alleges that these claims are not unpatentable over the applied references for the same reasons discussed with respect to claim 1 and because "Delaney and Khan do not cure the argued deficiencies of Owens and Narasimhan." (App. Br. 9.) Because Appellant has not provided any arguments regarding Hurst and Khan, or any additional arguments for claim 1, we will sustain the rejection

for the reasons discussed with respect to independent claim 1, from which claims 8 and 9 depend.

CONCLUSION

Based on the findings of facts and analysis above, we conclude that Appellant has not shown that the Examiner erred in rejecting claims 1-14 and 16.

DECISION

The rejection of claims 1-14 and 16 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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